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No. 1181

In The

Supreme Court of the United States

October Term 1967

CHESTER WAGNER, an individual, and
HENNY PENNY CORPORATION,
Petitioners,

v.

BALLANTYNE INSTRUMENTS & ELECTRONICS, INC.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

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No. ———

CHESTER WAGNER, an individual, and
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v.

BALLANTYNE INSTRUMENTS & ELECTRONICS, INC.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

Chester Wagner and Henny Penny Corp., your petitioners, pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Sixth Circuit, entered in the above entitled case on December 7, 1967.

OPINION BELOW

The opinion of the United States District Court for the Southern District of Ohio is reported at 260 F. Supp. 540. The opinion of the United States Court of Appeals for the Sixth Circuit has not been reported but is reprinted herein. (Appendix A, *infra*)

JURISDICTION

The judgment of the court of appeals affirming the district court's opinion was entered on December 7, 1967. (Appendix B, *infra*) No rehearing was sought. Jurisdiction of this Court is invoked under 28 U.S.C. § 1254 (1).

QUESTIONS PRESENTED

(a) Whether a patentee should be denied the benefit of the doctrine of equivalents because he has complied with the statutory requirement of distinctly claiming his invention.

(b) Whether the doctrine of file wrapper estoppel should be applied and a patentee denied the benefit of the doctrine of equivalents where the language of his patent claim was modified during the prosecution of his patent application to overcome the Patent Office's rejection that the claim failed to define the applicant's invention.

STATUTES INVOLVED

Section 112 of Title 35 of the United States Code provides in pertinent part:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Section 271 of Title 35 of the United States Code provides in pertinent part:

> § 271. Infringement of patent
>
> (a) Except as otherwise provided in the title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.
>
> (b) Whoever actively induces infringement of a patent shall be liable as an infringer.

STATEMENT OF FACTS

Ballantyne Instruments & Electronics, Inc. (respondent) filed a declaratory judgment action on December 13, 1961 against Chester Wagner (petitioner) requesting the court to hold Wagner patent No. 2,778,736 invalid and not infringed. Jurisdiction was claimed under 28 U.S.C. 1338, 28 U.S.C. 2201, and 28 U.S.C. 2202. Henny Penny Corporation (petitioner) was also joined as a defendant since it was licensed under the Wagner patent. Defendants counterclaimed, alleging that Ballantyne had infringed the Wagner patent and that it was valid.

On February 14, 1964, the district court granted Ballantyne's motion for summary judgment and held all three claims of the Wagner patent invalid in view of a publication written by Nola Treat and Lenore Richards entitled "Quantity Cookery". 227 F. Supp. 394. Wagner appealed this decision to the Sixth Circuit Court of Appeals. On May 13, 1965, the Court reversed the district court's decision insofar as it held Claims 2 and 3 invalid. 345 F.3d 671.

The case was tried before the district court on April 20 and 21, 1966. On July 20, 1966, the Court rendered its decision, holding Claims 2 and 3 valid and not infringed. On August 16, 1966, Wagner appealed from the finding of noninfringement. Ballantyne filed a cross appeal as to the Court's finding of validity. On December 7, 1967, the Court of Appeals affirmed the district court's opinion, relying on the reasons and the law set forth in the lower court's decision.

The Prior Art of Frying and the Patented Wagner Method of Deep Fat Pressure Frying

At the time of Wagner's invention in 1954, there were three principal ways to fry foods, and chicken in particular. The oldest one of course was to fry the chicken in an

ordinary frying pan on top of a stove. In some instances, the last few minutes of the cooking was done by baking the chicken in an oven. (204ja) * The second method was to fry the chicken while it was completely immersed in oil in an open, deep fat fryer. (185ja) The third method, detailed in "Quantity Cookery", *supra,* consisted of frying the chicken for several minutes in a deep bath of hot oil and then pressure cooking it at a temperature of about 250° F. (172ja) This is the method made famous by Colonel Sanders. (47ja)

For one reason or another these three methods were not entirely satisfactory for a commercial operation in that they either took a great deal of time, required constant supervision, the results were not reproducible or the product was grease logged. (185ja; 173ja)

In 1954, Mr. Chester Wagner invented a new method for frying food, a method whereby the food was fried at a sustained temperature of 325° F. while it was maintained under a pressure of about 15 pounds. (173ja) Although chicken is the major food on which the process is now practiced commercially, many other items can be fried according to the method. (305ja) For instance, potatoes, fish, carrots, oysters, scallops, short ribs, etc. can also be pressure fried. The method is described in detail in the Wagner patent and is covered by Claims 2 and 3 thereof. Briefly, his method as claimed in Claim 2 consists of the following steps: (171-172ja)

(1) Heating a bath of oil to about 310° F.

(2) Introducing the food to be cooked in the bath of hot oil and allowing it to cook for "a time sufficient to brown the food."

---

* Wagner, Henny Penny and Ballantyne filed a joint appendix in the Court of Appeals.

(3) Enclosing the food and continuing the frying at a temperature of about 310 to 325° F. while simultaneously maintaining a pressure of up to about 15 pounds to square inch and,

(4) Continuing the frying from five to seven minutes.

Claim 3 is similar to Claim 2 except it recites in lieu of step two that the food be cooked for 2 to 3 minutes prior to applying pressure. It also includes the additional step of completing the cooking cycle in approximately 10 minutes. (172ja)

The district court found that Wagner was the first person to practice this process. The court stated that:

> The methods claimed in Claims 2 and 3 of the Wagner patent 2,778,736 are the first disclosure in the art of a method of pressure frying chicken in which the chicken is maintained at a constant heat and a uniform pressure throughout the entire cooking cycle. (173ja)

The court also found that chicken cooked in accordance with the Wagner method was physically different from chicken cooked in accordance with the "Quantity Cookery" recipe, *supra,* in that the Wagner chicken had a deeper brown color, a crisper exterior and contains substantially less absorbed fat. (173ja)

The specification of the Wagner patent lists the following advantages of the Wagner method over the previous prior art methods of frying: (185-189ja)

(1) Control of the factors responsible for producing a quality product.
(2) Less shrinkage of food.
(3) Quicker.
(4) Superior product.
(5) Less fat consumption.

The Wagner method of deep fat pressure frying became an almost immediate success for Mr. Wagner and for his success he received the Feature Product Award of the Institutional Feeding and Housing Magazine. (329ja) It has been a success not only for Mr. Wagner and the Henny Penny Corporation, but also for Ballantyne. In the period from 1961 to 1963, Ballantyne sold approximately 2,000 of its "Flavor Crisp" deep fat pressure fryers. (323ja) When it is considered that each machine is capable of providing for its user a profit of $58.32 an hour, is it no wonder that so many pressure fryers have been sold? (325ja)

To support their charges that Ballantyne induced its users to use its pressure fryer in such a way that the Wagner patent was infringed, Wagner and Henny Penny relied principally upon the evidence presented at the trial by Ballantyne. The only real question as to whether Claims 2 and 3 were infringed was whether Ballantyne recommended the following step of Claim 2:

> introducing the food to be cooked into said hot bath of oil and cooking the same for a time sufficient to brown the food.

or the following step of Claim 3:

> Introducing the food to be cooked into said hot bath of oil and cooking it for from two to three minutes.

This step is the so-called "preliminary pre-cooking step." It precedes the step of pressure frying the food. It is old in the art, taught by the "Quantity Cookery" article, *supra*.

Ballantyne contended that the process that it instructed the users of its Flavor Crisp apparatus to use did not include the pre-cooking step, that instead of recommending this step it instructed its users to load the food *piece-by-piece* and *thereafter immediately* begin the pressure frying step.

Wagner and Henny Penny contended that this constituted a literal infringement of Claims 2 and 3 because some of the pieces of chicken placed into the fryer received the pre-cooking step even if the last one did not; but that even if there was no literal infringement, a case of infringement had been proved because the processes were legal equivalents since they operated in substantially the same way to give the same results.

The district court reviewed the file history of the Wagner patent and concluded that Wagner could not contend that the process Ballantyne instructed its customers to use was the legal equivalent of the patented process, because Wagner, by reason of the doctrine of file wrapper estoppel, was estopped from doing so.

The court made two crucial findings to support its holding.

> 16. When Chester Wagner first filed his patent application in the Patent Office, he disclosed a cooking method which included both a preliminary browning step with the container open and a final pressure cooking step with the container closed. Wagner's application claims which were not limited to this particular cooking process were rejected as unpatentable over the prior art and as not commensurate with Wagner's disclosure. In the Patent Office Action of November 1, 1956, the Patent Examiner held:
>
> > "Claims 22-24 are rejected as failing to define applicant's process since they do (not) recite the initial step of partially cooking the food in hot oil for a period of 2-3 minutes before enclosing the food and continuing the cooking of the food under pressure while the food is maintained in the bath of hot oil. It is axiomatic that the claims must be commensurate in scope with the disclosure."
>
> 17. In response to the Patent Office rejection, Wagner cancelled the rejected claims and presented three

> new application claims which became Claims 1, 2 and 3 of the issued patent. Each of these new claims include the preliminary browning step as a material limitation which was necessary to overcome the rejection and to induce the allowance of the claims. Wagner is now estopped to ignore or eliminate the preliminary browning step from patent Claims 2 and 3 since to do so would make these claims the same as the rejected claims which were cancelled and abandoned. (174ja)

It can be seen from the Examiner's statement in finding 16 that the claims were rejected as being indefinite, a rejection based on 35 U.S.C. 112. The rejection was *not* based on the prior art.

REASONS FOR GRANTING THE WRIT

The writ should be granted so that conflicting decisions of different United States Courts of Appeals and different Federal District Courts on an important question of patent law can be resolved.

In *Graver Tank & Mfg. Co., Inc.* v. *Linde Air Products Co.*, 339 U.S. 605 (1950), reh. den. 340 U.S. 845, the question of what constituted a patent infringement was before the Court. It held that in order to determine whether a patent was infringed

> resort must be had in the first instance to the words of the claim. If accused matter falls clearly within the claim, infringement is made out and that is the end of it. 339 U.S. at 607

The district court in the instant case concluded that the accused Ballantyne process did not fall within the literal language of the claims.

The Supreme Court recognized in the *Graver* case, however, that to permit an infringer to escape liability by subtle

and meaningless modifications would render the "patent grant a hollow and useless thing." The Court stated:

> But courts have also recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. Such a limitation would leave room for—indeed encourage—the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law. One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions, which is one of the primary purposes of the patent system. 339 U.S. at 607.

The doctrine of equivalents evolved to prevent such pirating.

> The doctrine of equivalents evolved in response to this experience. The essence of the doctrine is that one may not practice a fraud on a patent. Originating almost a century ago in the case of Winans v. Denmead, 15 How. 330, 14 L.Ed. 717, it has been consistently applied by this Court and the lower federal courts, and continues today ready and available for utilization when the proper circumstances for its application arise. "To temper unsparing logic and prevent an infringer from stealing the benefit of the invention" a patentee may invoke this doctrine to proceed against the producer of a device "if it performs substantially the same

> function in substantially the same way to obtain the same result." Sanitary Refrigerator Co. v. Winters, 280 U.S. 30, 42, 50 S. Ct. 9, 13, 74 L. Ed. 147. The theory on which it is founded is that "if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape." Union Paper-Bag Machine Co. v. Murphy, 97 U.S. 120, 125, 25 L. Ed. 935. 339 U.S. at 608.

The doctrine may be applied to improvement or secondary inventions as well as to pioneer inventions. 339 U.S. at 608.

The doctrine is not applicable where the patentee has, through his conduct in the Patent Office in attempting to distinguish the prior art, estopped himself from contending that one thing is the equivalent of another. This is the so-called "doctrine of file wrapper estoppel." It was recognized and applied by the Court in *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U.S. 126 (1942). There the Court stated:

> Assuming that the patentee would have been entitled to equivalents embracing the accused devices had he originally claimed a "conductor means embedded in the table", a very different issue is presented *when the applicant in order to meet objections in the Patent Office, based on references to the prior art, adopted the phrase as a substitute for the broader one "carried by the table"*. Had Claim 7 been allowed in its original form it would have read upon all the accused devices since in all the conductor means complementary to the coil spring are "carried by the table". By striking that phrase from the claim and substituting for it "embedded in the table" the applicant restricted his claim to those combinations in which the conductor means, though carried on the table, is also embedded in it. By the amendment he recognized and emphasized the difference between the two phrases and pro-

> claimed his abandonment of all that is embraced in that difference. . . . 315 U.S. 136 (emphasis ours)

The factual situation in the Exhibit case which gave rise to the application of the doctrine of file wrapper estoppel is considerably different from the one in the instant case. In the Exhibit case the patentee amended his claim in *order to distinguish the prior art cited by the Patent Office.* Had he not amended it, the article defined by it would have been unpatentable over the prior art. Afterwards, in litigation, he sought to enforce his patent against an infringer. However, in order to establish that the defendant was infringing he had to expand the scope of the claims. But, the scope which he was urging in court he had abandoned in the Patent Office by amendment. To allow this construction would have been to permit the patentee to recapture what the Patent Office required him to give up. In contrast to this is the situation which confronted Mr. Wagner. No prior art was cited by the Patent Office against his claims when the amendments in question were made. Instead, the examiner stated that Mr. Wagner had failed to distinctly and particularly claim his invention and that the claims were indefinite. The examiner pointed out that the rejection "is merely technical in character in that the proper amendment of the same would place this case in condition for allowance." (216ja) This is not the situation presented in the Exhibit case. To apply the file wrapper estoppel doctrine in this situation is to penalize the applicant for what he was required by statute to do, to distinctly claim the invention disclosed in his application.

The Supreme Court has not considered whether the file wrapper estoppel doctrine is applicable when the amendment was made to meet an indefiniteness rejection.

Several lower courts have considered the question and

as a result there is a conflict between the decisions of several courts of appeals and of several district courts.

In the recent case of *McCullough Tool Co.* v. *Well Surveys, Inc.*, 343 F.2d 381 (1965) the Tenth Circuit Court of Appeals considered this same question and held that there was no estoppel.

> McCullough next asserts that Swift is limited to an interrupted signal system and one pen recorder by virtue of the doctrine of file-wrapper estoppel. *However, the essence of the doctrine is that a patentee may not expand his allowed claims by interpretation to embrace features which he disclaimed in order to overcome objections by the Patent Office on the basis of prior art disclosures.* Doran Coffee Roasting Co. v. Wyott Manufacturing Co., supra. It is *not applicable where the patentee's difficulty results not from the wording and indefiniteness of the claims.* Sears, Roebuck & Co. v. Jones, supra. *In this case, the original claims upon which McCullough relies to invoke the doctrine were not rejected because they were unpatentable over the prior art. They were rejected on the formal grounds of being improper method claims and therefore file-wrapper estoppel is not applicable.* 343 F.2d at 403 (emphasis added)

In *Powder Power Tool Corp.* v. *Powder Actuated Tool Co.*, 230 F.2d 409 (1956), the Court of Appeals for the Seventh Circuit considered the same question and *held that the doctrine was applicable.*

The Sixth Circuit by affirming the decision of the district court in this case, has now chosen to align itself with the Seventh Circuit.

It is submitted that the Fifth Circuit aligned itself with the Tenth Circuit by its decision in *Hunt Tool Co.* v. *Lawrence*, 242 F.2d 347 (5th Cir. 1957) cert. den. 354 U.S. 910. The result of that decision is that a patentee is

permitted to expand a claim he amended to avoid the prior art so long as the expanded claims do not read on the prior art.

The following federal district courts have chosen to follow the rule enunciated by the Tenth Circuit Court of Appeals; *Abington Textile Work* v. *Carding Specialties Ltd.*, 249 F. Supp. 823 (D.D.C. 1965); *American Photocopy Equipment Co.* v. *Rovico, Inc.*, 257 F. Supp. 192 (N.D. Ill. 1966); *Cheiten* v. *Hancock-Gross Inc.*, 234 F. Supp. 717 (E.D. Pa. 1964); *Waterproof Insulation Corp.* v. *Insulating Concrete Corp.*, 153 F. Supp. 626 (D. Md. 1957); *Emerson* v. *National Cylinder Gas Co.*, 135 F. Supp. 268 (D. Mass. 1955).

The court's decision in the *Emerson* case was based on a set of facts quite similar to the one in the instant case. The court stated:

> Plaintiff's drawings submitted as part of his application for patent 741 showed tube 49, but his claim, instead of describing it as a tube, described it as "means within the casing defining a duct." The patent office rejected this specification as "not readable." This was, of course, technically correct. But if this was, as I hold it could be, a purely mechanical difference of no functional importance, and the rejection was not made because of any difficulty or objection of substance, such as lack of invention, infringement, or double patenting, it was a purely formal matter, and plaintiff's amendment substituting the words "a tube" for the seven words above quoted did not raise an estoppel against thereafter asserting equivalence in a matter of substance. Reece Button-Hole Mach. Co. v. Globe Button-Hole Mach. Co., 1 Cir., 61 F. 958. Therefore it could be found that defendants infringed patent 741, unless that patent is invalid. 135 F. Supp. at 271.

The rejection of "not readable" meant that the claims had failed to distinctly point out the invention.

The court in the *Abington Textile* case had the following to say about the doctrine of file wrapper estoppel.

> The doctrine of file wrapper estoppel is basically an equitable one, when properly understood and applied. When an applicant faced with a prior art rejection pursuant to 35 U.S.C. §§ 102 or 103 limits his claims in order to overcome the prior art rejection, it is inequitable for him to later assert that his patent coverage is of the same scope as it potentially was prior to amending his application claims in the Patent Office. If he had not inserted certain limitations in his claims it is presumed that the claimed subject matter would have been anticipated by, or obvious in view of, the cited prior art references. The same considerations do not apply to rejections other than prior art rejections, e.g., a rejection for undue *breadth of claims*. 249 F. Supp. at 842 (emphasis added)

The rejection in the instant case was similar to a rejection for "undue breadth of claims."

The court in *Ritter* v. *Rohm & Haas Co.*, 154 U.S.P.Q. 518 (S.D. N.Y. 1967) chose to apply the doctrine where the rejection was for indefiniteness.

The First Circuit has stated that there "is no real conflict, except linguistic" between these decisions. *Borg-Warner Corp.* v. *Paragon Gear Works, Inc.*, 355 F.2d 400 (1st Cir. 1965) writ of certiorari filed March 23, 1966, dismissed May 13, 1966. However, it did not offer any concrete suggestions for reconciling these opinions. What's more, it did not apply the doctrine of file wrapper estoppel even though the rejection of the Patent Office was for indefiniteness. The court stated:

> Review of the file wrapper as a whole discloses that

> the examiner's objection was that amounts were not indicated at all, i.e., that the invention was described only in terms of function. See fn. 8, supra. Hence when Seavey furnished details, although he was necessarily incorporating limitations, he gave up only an undescribed device. In these circumstances by asserting equivalence the plaintiff is not seeking to recapture what had been abandoned, because nothing having been previously stated, nothing had been abandoned. *The claims in other words, stand as claims initially made, entitled to the ordinary range of equivalents* . . . 355 F.2d at 406.

Applying this rationale here would result in a decision which would be contrary to the one reached by the Sixth Circuit Court of Appeals.

CONCLUSION

There is a real need for a decision of the Supreme Court on this issue. The question of whether the doctrine of equivalents is applicable in an infringement action arises very frequently since literal infringement is "a dull and very rare type of infringement." *Graver Tank Mfg. Co., supra* at 608. This determination is dependent on whether the doctrine of file wrapper estoppel is applicable. The application of this doctrine has not been harmonious among the courts. As a result, both the patentee and the public find themselves in a dilemma when they are confronted with the question of whether a patent whose claims were amended is being infringed. As a recent writer states:

> Hopefully, the Supreme Court will some day clarify the doctrine of file-wrapper estoppel, so that an applicant will be in a position to know in what situations he can safely rely on the doctrine of equivalents. *The*

Law of Chemical, Metallurgical and Pharmaceutical Patents, (page 371, Central Book Co., Inc. 1967).

Respectfully submitted,

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February, 1968.

APPENDIX A

OPINION BELOW

UNITED STATES COURT OF APPEALS
For The Sixth Circuit

Nos. 17407-08

BALLANTYNE INSTRUMENTS & ELECTRONICS, INC.,
Plaintiff-Appellee and Cross-Appellant,
v.
CHESTER WAGNER, an individual, and HENNY PENNY CORPORATION,
Defendants-Appellants and Cross-Appellees.

Appeal From the United States District Court for the Southern District of Ohio, Western Division

(Decided December 6, 1967.)

Before WEICK, Chief Judge, and PHILLIPS and CELEBREZZE, Circuit Judges.

PER CURIAM. This is a declaratory judgment action brought by Ballantyne Instruments & Electronics, Inc., (Ballantyne) against Chester Wagner and Henny Penny

Corporation, seeking to have Wagner's U. S. Patent No. 2,778,736 declared invalid. The three claims of this patent involve methods of deep fat cooking of foods, particularly fried chicken, under pressure.

The District Court originally sustained Ballantyne's motion for a summary judgment, holding that each claim of the patent in suit was anticipated by a method of frying chicken disclosed by the book "Quantity Cookery," published more than a year before the filing of the application for the patent.

In our opinion on the former appeal, reported at 345 F.2d 671, this Court affirmed the action of the District Court in holding the first claim to be invalid but reversed as to claims two and three, remanding the case for the taking of evidence on issues of fact relating to these two claims. Reference is made to the former opinion of this Court, written by Judge Arthur M. Smith of the United States Court of Customs & Patent Appeals, for a detailed discussion of the three claims of the patent and the issues involved.

Upon remand the District Court heard evidence and concluded that claims two and three of the Wagner Patent are not anticipated by the Quantity Cookery publication or by any patent or combination of patents in the prior art and that the invention of these two claims would not have been obvious to those skilled in the art. In detailed findings of fact and conclusions of law District Judge Carl A. Weinman held: (1) that claims two and three of the Wagner patent are valid; and (2) that under the applicable law and facts these two claims have not been infringed by Ballantyne.

Ballantyne has appealed from the judgment of the District Court insofar as it holds that claims two and three of the patent in suit are valid. The original defendants

have appealed insofar as the judgment holds that Ballantyne has not infringed the patent.

In essence Ballantyne's method contemplates placing the food in the pressure cooker, piece by piece, and then closing the cooker. Claims two and three of the Wagner patent provide for the so-called two-step cooking method, whereby after the oil is heated to a certain temperature the food is immersed in the oil for two or three minutes until it is browned and then the cooker is closed. The District Court concluded that the Ballantyne method does not infringe the patent.

We hold that the findings of fact of the District Judge that there was no infringement are not clearly erroneous, Rule 52 (a), Fed. R. Civ. P., but to the contrary are supported by substantial evidence. We further hold that the District Judge was correct in ruling that there was no infringement and that claims two and three of the patent are valid upon the authorities set forth in his findings of fact and conclusions of law.

Affirmed.

APPENDIX B

December 6, 1967

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Re: Ballantyne Instruments & Electronics, Inc. vs. Chester Wagner and Henny Penny Corporation — Nos. 17,407-8

Gentlemen:

The Court today announced its decision in the above-entitled cases, affirming the judgment of the District Court.

A copy of the Court's opinion is enclosed, and judgments in conformity with the opinion have been entered today as required by Rule 21(4).

Yours very truly,

Carl W. Reuss, Clerk

Deputy Clerk

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SUPPLEMENTAL APPENDIX TO PETITIONERS' PETITION FOR A WRIT OF CERTIORARI

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UNITED STATES DISTRICT COURT

Southern District of Ohio
Western Division

Civil Action No. 2672

BALLANTYNE INSTRUMENTS & ELECTRONICS, INC.,

Plaintiff,

vs.

CHESTER WAGNER and
HENNY PENNY CORPORATION,

Defendants.

ORDER

(Filed February 14, 1964)

In this matter, plaintiff has moved the Court to declare, by summary judgment, that United States Letters Patent No. 2,778,736 is invalid as a matter of law. The Court finds that plaintiff's motion is well taken.

The pleadings and exhibits show that there is no genuine issues as to any of the following material facts: On April 9, 1954, Chester Wagner filed an application for a patent on a method of deep fat cooking foods under pressure. The patent, with three claims, was issued on January 22, 1957 as United States Letters Patent No. 2,778,736.

Nola Treat and Lenore Richards are the authors of a printed publication, *Quantity Cookery*, Revised Edition, published by Little, Brown and Company, Boston, Massachusetts on January 12, 1951. At pages 233 through 236,

the authors of the aforementioned publication describe a method for frying chicken in deep fat.

The Court notes that the patent involved is sufficiently simple to obviate the necessity of expert testimony and summary judgment is a proper remedy for plaintiff. Bobertz v. G. M. Corp., 228 Fd2d 94 (Cir. 6 1955).

The Court finds that each claim of the patent in suit is anticipated by the method for frying chicken in deep fat as disclosed in *Quantity Cookery.* It follows that since the application for the patent was filed on April 9, 1954, which is more than one year after the publication of *Quantity Cookery,* the patent is invalid. See 35 U.S.C.A. § 102 (b).

Accordingly, it is hereby ORDERED, ADJUDGED and DECREED that plaintiff's motion for summary judgment is SUSTAINED and United States Letters Patent No. 2,778,736, and each claim thereof, is INVALID.

The Clerk shall enter judgment forthwith; entry of counsel not required.

/s/ CARL A. WEINMAN
Chief Judge
U. S. District Court

(CAPTION OMITTED)

OPINION OF THE SIXTH CIRCUIT COURT OF APPEALS

(Decided May 13, 1965)

Before WEICK, Chief Judge, PHILLIPS, Circuit Judge, and ARTHUR M. SMITH, Associate Judge:*

SMITH, Associate Judge. Plaintiff-appellee brought an action for declaratory judgment seeking to have Wagner U. S. Patent No. 2,778,736[1] declared invalid. In this action, plaintiff-appellee brought a motion for summary judgment which was granted by an order of the District Court which states:

> "The Court finds that each claim of the patent in suit is anticipated by the method for frying chicken in deep fat as disclosed in Quantity Cookery. It follows that since the application for the patent was filed on April 9, 1954, which is more than one year after the publication of Quantity Cookery, the patent is invalid. See 35 U.S.C.A. § 102 (b)."

The disclosure referred to in the above order is found on pages 233-36 of the publication Quantity Cookery by Nola Treat and Lenore Richards.[2]

The sole question for determination is whether the motion was properly sustained within the rationale of this court's decision in Bobertz v. General Motors Corp., 228 F.2d 94.

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* United States Court of Customs and Patent Appeals, sitting by designation.

[1] Issued Jan. 22, 1957 on an application filed Apr. 9, 1954.

[2] Revised Edition, published by Little, Brown and Company, Boston, Massachusetts on Jan. 12, 1951.

The public interest in every patent case requires that suits involving the validity of patents should be speedily determined. Thus, wherever patent litigation can be expeditiously handled on motions for summary judgment it should be done provided the necessary safeguards to protect the rights of the litigants are observed. One such safeguard is that enunciated in the Bobertz case, namely, that there be no real question of fact involved.

The patent in issue is entitled "Method of Deep Fat Cooking of Foods Under Pressure" and contains three claims in which the invention is set forth as comprising a series of interrelated steps as follows:

1—establishing a bath of hot oil, heated to approximately 310°-325° F,

2—introducing the food to be cooked into the hot oil bath and allowing it to cook for a time sufficient to brown the food,

3—thereafter enclosing the same and continuing the cooking under a pressure of up to about 15 pounds per square inch for a period of time to cook the food.

Claim 1 of the patent calls for "simultaneously maintaining" the food in the bath of hot oil and cooking it under a specified pressure, while claim 2 differs from it in that it requires the oil temperature in the final pressure cooking step to be "about 315 to 325° F." Claim 2 also requires a final cooking period of from 5 to 7 minutes.

Claim 3 differs from claims 1 and 2 in requiring that the initial cooking be for "from 2 to 3 minutes" and, like claim 2, requires that the final cooking under pressure be at a "temperature of about 315-325° F." It differs from both claims 1 and 2 in requiring that the complete cooking operation is limited in time to "approximately ten minutes."

The relationship between the Quantity Cookery publi-

cation and claim 1 of the patent in suit is conveniently illustrated as follows in plaintiff-appellee's brief in Chart 1 entitled:

Comparison Between Methods for Deep Fat Pressure Cooking of Food as Taught by Quantity Cookery Publication and Wagner Patent 2,778,736.

QUANTITY COOKERY PUBLICATION (at page 236, paragraphs 5 & 6).	WAGNER PATENT CLAIM 1
"FRIED CHICKEN, KENTUCKY STYLE"	"An improved method of deep fat cooking of foods under pressure in a minimum of time which consists of the steps of:"
(a.) "Put at once into the bottom of a pressure cooker, two-thirds filled with hydrogenated fat at 325° F."	(a.) "Establishing a bath of hot oil, said bath of oil being heated to about 310° to 325° F."
(b.) "Cook uncovered until a very light but even golden brown."	(b.) "Introducing the food to be cooked into said hot bath of oil and allowing it to cook for a time sufficient to brown the food, and"
(c.) "When chicken is slightly brown put on the cover and bring the pressure up to fifteen pounds."	(c.) "Thereafter enclosing the same and continuing the cooking while simultaneously maintaining the food in said bath of hot oil and cooking the same under a pressure of up to about 15 pounds per square inch."
(d.) "Cook chicken at fifteen pounds pressure for seven minutes."	(d.) "And while thus immersed in said hot oil for a period of time to cook the food."

To complete the picture we observe that there is nothing in the Quantity Cookery publication nor in claim 1 of the Wagner patent which establishes a definite temperature requirement for step (d) indicated in the chart.

The decision of the District Court that the patent in suit was "invalid as a matter of law" is predicated on 35 U.S.C. § 102(b), which provides in pertinent part:

> "A person shall be entitled to a patent unless * * * the invention was * * * described in a printed publication * * * more than one year prior to the date of the application for patent in the United States."

Thus, resolution of the sole question presented turns on whether, within the meaning of 35 U.S.C. § 102(b), the Quantity Cookery publication "describes" the invention as it is claimed in the three claims of the Wagner patent.

To constitute a "description" of the patented invention within the meaning of 35 U.S.C. § 102(b) the prior publication must describe the invention as claimed in such full, clear and exact terms as to enable any person skilled in the art or science to which the invention appertains, to practice the invention. Vague and general representations are not sufficient in law to support the defense of anticipation under 35 U.S.C. § 102(b). See Seymour v. Osborne, 11 Wall. 516, 78 U.S. 516, 20 L.Ed. 33, Downton v. Yeager Milling Co., 108 U.S. 466, 3 S.Ct. 10, 27 L.Ed. 789, Eames v. Andrews, 122 U.S. 40, 66, 7 S.Ct. 1073, 30 L.Ed. 1064, Cohn v. United States Corset Co., 93 U.S. 366, 23 L.Ed. 907, Allied Wheel Prods. Inc. v. Rude, 6 Cir., 206 F.2d 752.

In determining whether any real issue of fact is here presented, each of the three claims of the patent must be considered separately, for "in contemplation of law, each claim of the patent must be considered as setting forth a complete and independent invention." Railroad Supply Co. v. Hart Steel Co., 222 F. 261 (C.A. 7th 1915). There

is nothing in the record before us to indicate that separate consideration was given to each claim by the District Judge before granting appellee's motion for summary judgment. If this matter was presented to the District Judge as it was here presented in appellee's brief, the claims were not so considered. We find no indication in the record that the above mentioned differences in claims 2 and 3 were considered by the District Judge.

35 U.S.C. § 282 provides, "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it." We find plaintiff-appellee did not discharge this burden as to claims 2 and 3. As above pointed out, the Quantity Cookery publication does not disclose the temperature limits to be maintained in the final pressure cooking step as called for in claims 2 and 3, nor does it disclose the over-all time limits called for in claim 3.

In opposition to plaintiff-appellee's motion for summary judgment, defendants-appellants introduced affidavits of Dr. Wilbur A. Gould and Col. Harland D. Sanders as persons skilled in this art. These affidavits raise questions of fact as to a) the nature of the final cooked product when cooked according to the process described in the Quantity Cookery publication and when cooked according to the process claimed in claims 2 and 3 of the patent in suit, and b) the temperatures at which the final cooking step is in fact performed in the process described in the Quantity Cookery publication.

Since the process described in the Quantity Cookery publication discloses a process substantially as claimed in claim 1, we agree with the District Judge that the invention defined in this claim is "described" within the meaning of 35 U.S.C. § 102(b). The order sustaining plaintiff's motion for summary judgment as to claim 1 is therefore sustained.

However, real factual issues are presented as to claims 2 and 3 concerning: a) what the Quantity Cookery publication *in fact* teaches one skilled in this art as to the temperatures used in the pressure cooking step therein disclosed, and b) whether the time and temperature requirements specified in these claims are *in fact* different from what the Quantity Cookery publication teaches.

We find, therefore, that it was error to grant plaintiff's motion for summary judgment under 35 U.S.C. § 102 (b) as to claims 2 and 3.

In view of the foregoing, the order sustaining plaintiff's motion for summary judgment is affirmed as to claim 1 of the patent in suit and is reversed as to claims 2 and 3 thereof, and the cause is remanded for further proceedings consistent herewith.

(CAPTION OMITTED)

FINDINGS OF FACT, CONCLUSIONS OF LAW AND JUDGMENT OF THE UNITED STATES DISTRICT COURT, SOUTHERN DISTRICT OF OHIO, WESTERN DIVISION

(Filed July 20, 1966)

This matter was originally before the Court upon plaintiff's motion for summary judgment. On February 14, 1964 the Court found that each claim of the patent in suit was anticipated by the method for frying chicken in deep fat as disclosed in the publication Quantity Cookery (Revised Edition, published by Little, Brown and Company, Boston, Massachusetts on January 12, 1951) and that since the application for the patent was filed more than one year after said publication, the patent was invalid. On

appeal to the Court of Appeals for the Sixth Circuit, that Court sustained the summary judgment as to claim 1 of the patent in suit and reversed as to claims 2 and 3. The Court of Appeals stated:

> ". . . real factual issues are presented as to claims 2 and 3 concerning: a) what the *Quantity Cookery* publication *in fact* teaches one skilled in this art as to the temperatures used in the pressure cooking step therein disclosed, and b) whether the time and temperature requirements specified in these claims are *in fact* different from what the *Quantity Cookery* publication teaches."

The trial relating to claims 2 and 3 of the patent in suit was heard by the Court and the Court having observed the witnesses and considered their testimony and the evidence, which included various exhibits, together with the arguments and briefs of counsel, and being fully advised of the premises now makes the following findings of fact and conclusions of law.

FINDINGS OF FACT

1. Plaintiff, Ballantyne Instruments & Electronics, Inc., is a Delaware Corporation having its principal place of business at Omaha, Nebraska, where it manufactures and sells deep-fat pressure cooking apparatus under its trademark "Flavor Crisp" for the restaurant and institutional trade.

2. Defendant, Chester Wagner, resides at Eaton, Ohio and is the president of defendant, Henny Penny Corporation, an Ohio Corporation, having a regular and established place of business in Eaton, Ohio, which is within this judicial district. Defendant, Henny Penny, manufactures and sells deep-fat pressure cooking apparatus under the trade-mark "Henny Penny."

3. Defendant Chester Wagner is the patentee and owner of United States Letters Patent No. 2,778,736, a process patent.

4. The patent in issue is entitled "Method of Deep Fat Cooking Foods Under Pressure" and contains three claims in which the invention is set forth as comprising a series of interrelated steps as follows:

1 — establishing a bath of hot oil, heated to approximately 310° - 325° F.

2 — introducing the food to be cooked into the hot oil bath and allowing it to cook for a time sufficient to brown the food.

3 — thereafter enclosing the same and continuing the cooking under a pressure of up to about 15 pounds per square inch for a period of time to cook the food.

5. Claim 1, which the Court of Appeals has held to be invalid, calls for "simultaneously maintaining" the food in the bath of hot oil and cooking it under a specified pressure.

6. Claim 2 differs from claim 1 in that it requires the oil temperature in the final pressure cooking step to be "about 315 to 325° F." Claim 2 also requires a final cooking period of from 5 to 7 minutes.

7. Claim 3 differs from claims 1 and 2 in requiring that the initial cooking be for "from two to three minutes" and, like claim 2 requires that the final cooking under pressure be at a "temperature of about 315-325° F." It differs from both claims 1 and 2 in requiring that the complete cooking operation be limited in time to "approximately ten minutes."

8. The Quantity Cookery publication was published in 1951, several years before Chester Wagner filed his patent application. At page 236 of the publication, after describing the method of preparing the chicken, the following method of cooking is stated:

"5. Put at once into the bottom of a pressure cooker, two-thirds filled with hydrogenated fat at 325° F., and cook uncovered until a *very* light but even golden brown. (Depending on size of the cooker, cook four, six or eight quarters at one time.)"

"6. When chicken is slightly brown put on the cover and bring the pressure up to fifteen pounds. Cook chicken at fifteen pounds pressure for seven minutes."

9. The Quantity Cookery publication is silent as to the temperature of the hot oil in the container during the final pressure cooking step.

10. The Payne patent 2,532,639 was filed on November 18, 1946 and issued on December 5, 1950. Payne discloses a deep fat pressure cooking apparatus which has both pressure relief means for maintaining the pressure within the pot at a desired value, and thermostat means for maintaining the temperature of the hot oil within the pot at a desired value. The Payne patent is directed to a deep fat pressure cooking apparatus and does not specifically teach any particular cooking method time, temperature or pressure limitations.

11. The methods claimed in claims 2 and 3 of the Wagner patent 2,778,736 are the first disclosure in the art of a method of pressure frying chicken in which the chicken is maintained at a constant heat and a uniform pressure is maintained throughout the entire cooking cycle.

12. Chicken pressure fried in accordance with the methods of claims 2 and 3 of Wagner patent 2,778,736 is substantially different in nature from that prepared in accordance with the Quantity Cookery publication in that it has a crisper exterior, has a higher percentage of internal moisture, has a deeper brown color and contains substantially less absorbed fat.

13. The invention of claims 2 and 3 of Wagner patent 2,778,736 would not have been obvious to those skilled in the art in the light of Payne patent 2,532,639.

14. The methods claimed in claims 2 and 3 of Wagner patent 2,778,736 are not anticipated by any patent or combination of patents in the prior art.

15. The methods claimed in claims 2 and 3 of the Wagner patent 2,778,736 are not anticipated by the prior art cited by the plaintiff. Also, these methods are not anticipated by a theoretical combination of the Quantity Cookery publication and the Payne patent 2,532,639.

16. When Chester Wagner first filed his patent application in the Patent Office, he disclosed a cooking method which included both a preliminary browning step with the container open and a final pressure cooking step with the container closed. Wagner's application claims which were not limited to this particular cooking process were rejected as unpatentable over the prior art and as not commensurate with Wagner's disclosure. In the Patent Office action of November 1, 1956, the Patent Examiner held:

> "Claims 22-24 are rejected as failing to define applicant's process since they do [not] recite the initial step of partially cooking the food in hot oil for a period of 2-3 minutes before enclosing the food and continuing the cooking of the food under pressure while the food is maintained in the bath of hot oil. It is axiomatic that the claims must be commensurate in scope with the disclosure."

17. In response to the Patent Office rejection, Wagner cancelled the rejected claims and presented three new application claims which became claims 1, 2 and 3 of the issued patent. Each of these new claims include the preliminary browning step as a material limitation which

was necessary to overcome the rejection and to induce the allowance of the claims. Wagner is now estopped to ignore or eliminate the preliminary browning step from patent Claims 2 and 3 since to do so would make these claims the same as the rejected claims which were cancelled and abandoned.

18. More than two years after his patent was issued Wagner filed an application to re-issue his patent by adding four new claims which were broader than the cooking method covered by Claims 1, 2 and 3 of the original patent. He attempted to obtain claims which eliminated the preliminary browning step and which merely defined the concept of closing the lid after the food was loaded into the pot so that the food would be browned and cooked in a single operation. The Patent Office action of August 3, 1959 rejected Wagner's attempt to broaden his patent on the grounds that the patent contains no basis or disclosure for the broadened concept. In response to the rejection of his re-issue application claims, Wagner abandoned his re-issue application. This further rejection by the Patent Office strengthens the estoppel against any construction of Wagner claims 2 and 3 for a cooking method which does not include his particular preliminary browning step and final pressure cooking step under the specific temperature, time and pressure limitation set forth in these claims.

19. The Court finds that plaintiff, Ballantyne Instruments & Electronics, Inc., has not used, nor actively induces any others to use, the particular cooking method defined by Wagner claims 2 and 3. Said plaintiff has always used, and has always taught others to use, its Flavor-Crisp apparatus so that the lid would be closed and the food cooked under pressure immediately after all the food is placed into the hot oil.

20. Defendants are not entitled to apply the doctrine of equivalents in order to make Wagner claims 2 and 3 cover the method used by plaintiff in its Flavor-Crisp apparatus. The preliminary browning step is a critical limitation of these claims under the doctrine of file wrapper estoppel. Defendants cannot make plaintiff's method the legal equivalent of Wagner's claimed method since recourse may not be had to the doctrine of equivalents to recapture claims which Wagner surrendered by amendment and cancellation of his original application claims.

CONCLUSIONS OF LAW

1. The Court has jurisdiction of the subject matter and the parties to this action.

2. The claims of the patent in suit are presumed to be valid and the burden of establishing invalidity is upon the party who is urging invalidity. § 282, Title 35, U.S.C.A. and Mumm v. Jacob E. Decker & Sons, 301 U.S. 168, 171 (1937).

3. The burden of proof upon the party asserting the invalidity of a patent is proof which is clear and satisfactory; it must be proof which will convince the Court beyond a reasonable doubt. Cutting Room Appliances Corp. v. Weatherbee Coats, Inc., 158 F. Supp. 231, 233 (D.C.N.D. Ohio 1950) affirmed, 250 F.2d 39 (6 Cir. 1957) and Mumm v. Jacob E. Decker & Sons, supra, at page 171.

4. The relevant statutes to be considered in this action are § 101, § 102 (b) and § 103 of Title 35, U.S.C.A. which provide as follows:

> § 101. "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

§ 102. "The person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in this country, more than one year prior to the date of the application for patent in the United States . . ."

§ 103. "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

5. There are three elements requisite to validity of a patent: novelty, utility and invention. Graham v. John Deere Co., 383 U.S. 1 (1966), Harvey v. Levine, 322 F.2d 481, 483 (6 Cir. 1963); Maytag Company v. Murray Corporation of America, 318 F.2d 79, 81 (6 Cir. 1963); Aluminum Company of America v. Sperry Products, Inc., 285 F.2d 911, 917 (6 Cir. 1960), cert. denied, 368 U.S. 890 (1961); and Allied Wheel Products, Inc. v. Rude, 206 F.2d 752, 760 (6 Cir. 1953).

6. Applying the applicable law to the facts as hereinbefore found, the Court concludes that claims 2 and 3 of United States Letters Patent 2,778,736 are valid.

7. The burden of proving patent infringement rests upon the party charging infringement. United States Rubber Co. v. General Tire and Rubber Co., 128 F.2d 104 (6 Cir. 1942), and Aluminum Co. of America v. Thompson Products Inc., 122 F.2d 796 (6 Cir. 1941).

8. Where limitations on claims suggested by Patent Office and acquiesced in by patentee are adopted to avoid earlier grounds of rejection and to obtain allowance of patent, the patentee is estopped from denying limiting effect of the language in the claims as issued. Parke, Davis & Co. v. American Cyanamid Co., 207 F.2d 571 (6 Cir. 1953).

9. The claims of a patent must be read in light of the specifications, drawings and file wrapper history and may not be given a construction broader than the teachings of the patent. Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211 (1940), opinion amended and petition for rehearing and the motion to remand denied, 312 U.S. 654 (1940); Tillotson Manufacturing Company v. Textron, Inc., Homelite, 337 F.2d 833 (6 Cir. 1964) and Cincinnati Milling Machine Co. v. Turchan, 208 F.2d 222 (6 Cir. 1953).

10. In Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211 (1940) the Supreme Court stated:

> ". . . where the patentee in the course of his application in a patent office has, by amendment cancelled or surrendered claims, those which are allowed are to be read in the light of those abandoned and an abandoned claim cannot be revived and restored to the patent by reading it by construction into the claims which are allowed. . . ." [At page 218].
>
> * * * *
>
> "It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected, and the claims allowed cannot by construction be read to cover that which was eliminated from the patent . . . The patentee may not by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer . . . The injurious con-

sequences to the public and to inventors and patent applicants if patentees were thus permitted to revive cancelled or rejected claims and restore them to their patents are manifest. . . ." [At pages 220-221].

11. What the patentee has lost by disclaimer cannot be regained by recourse to the doctrine of equivalents. Exhibit Supply Co. v. Ace Patents Corporation, 315 U.S. 512 (1942).

12. Applying the applicable law to the facts as hereinbefore found, the Court concludes that claims 2 and 3 of United States Letters patent 2,778,736 have not been infringed by Ballantyne Instruments & Electronics, Inc.

JUDGMENT

In accordance with the foregoing findings of fact and conclusions of law, it is hereby ORDERED, ADJUDGED and DECREED;

That claims 2 and 3 of United States Letters patent 2,778,736 are valid and

That plaintiff, Ballantyne Instruments & Electronics, Inc., has not infringed claims 2 and 3 of said Letters patent 2,778,736.

Carl A. Weinman
Chief Judge,
U. S. District Court

SUPREME COURT, U. S.

APR 1 1968

JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1967.

No. 1181

CHESTER WAGNER, AN INDIVIDUAL, and HENNY PENNY CORPORATION,

Petitioners,

vs.

BALLANTYNE INSTRUMENTS & ELECTRONICS, INC.,

Respondent.

BRIEF FOR RESPONDENT OPPOSING PETITION FOR WRIT OF CERTIORARI.

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March 29, 1968.

THE BURTHORP-WARREN PRINTING COMPANY, CHICAGO

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Supreme Court of the United States

OCTOBER TERM, 1967.

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CHESTER WAGNER, AN INDIVIDUAL, and HENNY PENNY CORPORATION,

Petitioners,

vs.

BALLANTYNE INSTRUMENTS & ELECTRONICS, INC.,

Respondent.

BRIEF FOR RESPONDENT OPPOSING PETITION FOR WRIT OF CERTIORARI.

To The Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Respondent submits this Brief in opposition to the Petition for Writ of Certiorari to show that the Petition presents no ground which justifies the granting of the Writ.

OPINIONS BELOW.

The Opinion of the Court of Appeals for the Sixth Circuit (Supp. App. to Petition, p. 3) holding Claim 1 of Wagner Patent No. 2,778,736 "invalid" is reported at 345 F. 2d 671 (1965), and its Opinion (App. A of Petition) holding patent Claims 2 and 3 "not infringed" by Defendant is reported at 386 F. 2d 789 (1967). Only the latter opinion is involved in the Petition.

JURISDICTION.

The jurisdictional requisites are set forth in the Petition.

QUESTION PRESENTED.

The Petition sets forth two questions upon which review is sought. These concern the technical doctrines of equivalents and file wrapper estoppel, neither one of which was discussed by the Court of Appeals in its opinion affirming the District Court. Since the holding of non-infringement is supported by several findings of fact, it is submitted that the question should be presented as follows:

Should the Supreme Court exercise its certiorari jurisdiction in a case:

(a) where the patent monopoly relates to a mere recipe or method of deep fat pressure cooking of food, and

(b) where the Court of Appeals held that the findings of non-infringement "are supported by substantial evidence" and

(c) where the file wrapper estoppel applied by the District Court followed the standards consistently laid down by the Supreme Court as well as the lower courts

such that there is no conflict of decisions or unsettled federal question here involved?

STATEMENT.

Since only a cooking recipe is involved, the facts of this patent case are relatively simple. They should be reviewed, however, so that the question presented here can be understood in its proper context.

Wagner patent 2,778,736 is directed to a METHOD OF DEEP FAT COOKING FOODS UNDER PRESSURE and a recipe having these two cooking steps:

> (1) introducing the food to be cooked into a bath of hot oil heated to 310° F.-325° F. and allowing it to cook for a time sufficient to brown the food, and
>
> (2) thereafter enclosing the same and continuing the cooking under a pressure of up to about 15 pounds per square inch for a period of time to cook the food. (Supp. App. to Petition, p. 4.)

The first cooking step is a preliminary browning step with the cooking pot open to the atmosphere. The second cooking step requires the cooking pot to be closed so that a pressure of 15 pounds per square inch can be maintained. The patent states that for an average size 1½ pound chicken, the first step takes 2 to 3 minutes and the second step takes 5 to 7 minutes.

When the patentee, Wagner, first filed his patent application in the Patent Office, he presented broad claims which covered only the final pressure cooking step and which did not include the limitation of a preliminary browning step prior to the pressure cooking step. These unduly broad claims were rejected by the Patent Office as follows:

> "Claims 22-24 are rejected as failing to define applicant's process since they do not recite the initial step of partially cooking the food in hot oil for a period of 2-3 minutes before enclosing the food and continuing the cooking of the food under pressure while the food

is maintained in the bath of hot oil. It is axiomatic that the claims must be commensurate in scope with the disclosure." (Supp. App. to Pet., p. 12.)

Wagner acquiesced in this Patent Office rejection by cancelling his broad one-step cooking claims and presenting new, narrowed claims which were ultimately granted to become the claims of his issued patent. Each of these new claims expressly included both (1) the initial browning step and (2) the final pressure cooking step required by the Patent Office as material limitations necessary to overcome the rejection and to induce the allowance of the claims. (Supp. App. to Pet., p. 12.)

More than two years after the issuance of his patent with these narrowed claims, Wagner sought to re-issue his patent by presenting new claims 4-7 again covering only the final pressure cooking step. These new claims did not define the preliminary browning step and, if allowed, would have covered the operation of closing the lid of the pot for pressure cooking as soon as all of the food was loaded therein. (Supp. App. to Pet., p. 13.) The Patent Office again rejected Wagner's attempt to obtain such unduly broad claims:

> "Claims 4-7 are rejected as involving new matter and based upon an inadequate disclosure in the instant application since there is no specific basis for the following limitations . . . the concept of browning and cooking the meat in one operation. No antecedent basis is found in the instant application . . . for carrying out the browning and cooking of the meat in one operation. (R. 251ja, 252ja.)

Wagner acquiesced in the Patent Office refusal of claims not expressly limited to his two step cooking method and he allowed his re-issue application to become abandoned. (Supp. App. to Pet., p. 13.)

The District Court found that the Respondent has not infringed Wagner's two-step cooking method, but, to the contrary, has always caused the lid to be closed for pressure cooking *immediately* after all of the food is placed in the hot oil. (Supp. App. to Pet., p. 13.) The preliminary browning step, so essential to the allowance of the Wagner patent claims, has never been used by Respondent. The Court of Appeals held that such findings of non-infringement were "supported by substantial evidence". (App. A of Pet., p. 19.)

ARGUMENT.

The issue presented by the Petition concerns a narrow point of patent law which is only ancillary to the main issues of this case. Petitioners' asserted question does not warrant review by this Court on certiorari and particularly where no conflict of decision or unsettled question of federal law exists.

The opinion of the District Court and the affirming opinion of Court of Appeals relating to non-infringement could not have been more clearly expressed—the patent monopoly covers only a two-step cooking method and Respondent uses only a one-step cooking method. Since the patent claims do not cover respondent's recipe, there can be no infringement and the decision below clearly is correct.

I.

PETITIONERS ARE ESTOPPED TO RECAPTURE THE CANCELLED CLAIMS AND CANNOT MAKE THE PATENTED TWO STEP COOKING METHOD THE EQUIVALENT OF RESPONDENT'S ONE STEP COOKING METHOD.

The first point asserted by Petitioners is that they should not be denied a broad interpretation of the patent claims merely because Wagner complied with the Patent Statute in distinctly claiming the invention. (Pet., p. 2.) This assertion is a nimble reversal of the actual point here which is whether Petitioners should be permitted to interpret the issued patent claims so as to convert them back into their original indefinite and abandoned form.

Section 112 of Title 35, United States Code, requires the patent claim to particularly point out and distinctly claim

the disclosed invention. (Pet., p. 2.) Since the Wagner Patent application disclosed only a two-step method having a preliminary browning step and a final pressure cooking step, the Patent Office rejected all of the initially presented claims which covered only one cooking step and which were not "commensurate in scope with the disclosure". (Supp. App. to Pet., p. 12.) Wagner cured this indefiniteness and failure to meet the statutory requirements by abandoning the one-step method claims and by presenting new claims expressly limited to his disclosed two-step method.

Petitioners now make the wholly illogical argument that because Wagner was made to comply with the statute requiring distinct claiming of the invention, they now should be permitted under the doctrine of equivalents to interpret the two-step method claims to cover Respondent's single step method. Manifestly, if Petitioners were allowed to do this, these claims would revert back to their original indefinite scope—and the statutory requirement would again be violated.

The opinions below correctly held that as a result of their Patent Office prosecution of Wagner patent, Petitioners are estopped to revive the rejected and cancelled one-step method claims and restore them to the Wagner patent (Supp. App. to Pet., p. 13). In the second point raised by the Petition (Pet., p. 2), Petitioners assert that file wrapper estoppel should be applied only where the claims have been amended to overcome the prior art and should not be applied where such amendment is made to overcome a rejection based upon a violation of the Patent Statute requiring the claim to be definite and to particularly point out the disclosed invention. (Pet., p. 11.) There is no basis in any prior Supreme Court decision for this alleged distinction, and there is no conflict of decisions among the lower Courts on this point. The cases relied upon by Petitioners are distinguishable both in fact and in their application of the law from the position being urged by Petitioners.

II.

THE DOCTRINES OF EQUIVALENTS AND FILE WRAPPER ESTOPPEL HAVE LONG BEEN RECOGNIZED BY THIS COURT.

There can be no unsettled question at this late date that a patentee may not equate his issued patent claims with those which he had cancelled and abandoned in order to induce the allowance of the issued claims. In *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U. S. 211 (1940), this Court stated:

> "... where the patentee in the course of his application in a patent office has, by amendment cancelled or surrendered claims, those which are allowed are to be read in the light of those abandoned and an abandoned claim cannot be revived and restored to the patent by reading it by construction into the claims which are allowed. ... " [At page 218.]
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> "It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected, and the claims allowed cannot by construction be read to cover that which was eliminated from the patent ... The patentee may not by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer ... The injurious consequences to the public and to inventors and patent applicants if patentees were thus permitted to revive cancelled or rejected claims and restore them to their patents are manifest. ..." [At pages 220-221.]

These doctrines were re-affirmed in this Court's recent opinion in *Graham* v. *John Deere Company of Kansas City*, 383 U. S. 1 (1966):

> "Here, the patentee obtained his patent only by ac-

cepting the limitations imposed by the Examiner. The claims were carefully drafted to reflect those limitations and Cook Chemical is not now free to assert a broader view of Seoggin's invention." [At page 34.]

The instant case falls squarely under this unequivocal and long standing rule of law. Wagner eliminated the one-step cooking method claims and accepted the limitations imposed by the Examiner by presenting narrowed claims drawn only to a two-step cooking method. The lower Courts correctly held that Petitioners were estopped to broaden the Wagner claims in suit and that the one-step method claims surrendered by disclaimer could not be regained by recourse to the doctrine of equivalents. (Supp. App. to Pet., p. 17.)

III.

THERE IS NO CONFLICT OF DECISION INVOLVED UNDER THE FACTS OF THIS CASE.

Petitioners have argued that the Courts have not agreed upon the application of file wrapper estoppel where the claims are amended to overcome a Patent Office rejection based upon reasons other than prior art. (Pet., p. 12.) In reply, it first is noted that such a distinction that file wrapper estoppel is applicable in some instances but not in others has never been recognized or asserted by the Supreme Court. Rather, the Court has, in consistent and unequivocal holdings, stated that the allowed claims of a patent cannot by construction be read to cover claims which were rejected and cancelled. The Supreme Court never has recognized any exception to exist where the cancelled claims were rejected for indefiniteness rather than for prior art. To the contrary, these rules apply in all instances to prevent the injurious consequences which would result if patentees were permitted to revive cancelled claims and restore them to their patents.

Further, the alleged conflict between the Tenth Circuit case of *McCullough Tool Co.* v. *Well Surveys, Inc.*, 343 F. 2d 381 (1965) and the Seventh Circuit case of *Powder Power Tool Corp.* v. *Powder Actuated Tool Co.*, 230 F. 2d 409 (1956) does not stand up under careful analysis of these opinions. The supposed conflict between these cases was carefully considered by the First Circuit in *Borg-Warner Corp.* v. *Paragon Gear Works, Inc.*, 355 F. 2d 400 (1965), and that court held that "there is no real conflict, except linguistic" between these decisions. In fact situations where the patentee did not abandon anything, of course, the doctrine of file wrapper estoppel did not apply. However, in cases, like the one at bar, where originally claimed subject matter was abandoned in favor of newly claimed, more narrow, subject matter, the patentee was clearly estopped from recapturing the abandoned material.

Of particular importance here is the First Circuit's refusal to recognize any distinction based upon the nature of the Patent Office rejection, whether on prior art or indefiniteness or for any other ground:

> "If an applicant who accedes to a demand based upon the prior art is thereafter estopped to contest its necessity, he should equally be estopped to deny the correctness of a demand for which some other reason is given. To a party examining the file to determine the true scope of what has been granted, and finding something affirmatively disclaimed, it should make no difference what was the purpose of the disclaimer." [At page 406.]

In the present case, it is undisputed that the Wagner patent involves claims for a two-step cooking method which were obtained only after the patentee cancelled the rejected claims covering a one-step cooking method. Under these facts, all of the authorities are in agreement that Petitioners are estopped to now broaden the patent claims to cover the

subject matter of the abandoned claims. This is not a case where the patentee abandoned nothing and therefore is entitled to the doctrine of equivalents.

There is no conflict of decision or unsettled question of federal law for this Court to review.

CONCLUSION.

For the foregoing reasons it is submitted that the Petition should be denied.

Respectfully submitted,

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